

Application No.: 10/019,988**Atty Docket: 3COM 2487-3****REMARKS**

Claims 1-63 are pending in this application and are currently rejected to by the Examiner. Claims 30-35 and 47 are rejected under 35 USC § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The pending claims are rejected under 35 USC § 103(a) as being unpatentable over various combinations of art, all combinations sharing Prithviraj et al. (U.S. Patent No. 5,987,513, hereinafter "Prithviraj") in view of Adams et al. (U.S. Patent No. 6,185,566, hereinafter "Adams").

Claims 49 and 50 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj-Adams.

Claims 1, 2, 6-11, 24-26, 30-35, 48 and 53-60 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams and further in view of Brim (U.S. Patent No. 5,835,914, hereinafter "Brim").

Claims 3, 4, 27 and 28 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, and further in view of Flack et al. (U.S. Patent No. 6,288,704, hereinafter "Flack").

Claims 5 and 29 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, and further in view of Lammung et al. (U.S. Patent No. 5,862,321, hereinafter "Lammung").

Claims 12, 13, 36 and 37 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, and further in view of Haitani et al. (U.S. Patent No. 5,900,875, hereinafter "Haitani").

Claims 14, 16, 21, 22, 38, 40, 45 and 46 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, and further in view of Vatanen (U.S. Patent No. 6,237,093, hereinafter "Vatanen").

Claims 15 and 39 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, further in view of Vatanen, and further in view of Haitani.

Application No.: 10/019,988**Atty Docket: 3COM 2487-3**

Claims 17 and 41 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, and further in view of Shipley (U.S. Patent No. 5,818,617, hereinafter "Shipley").

Claims 18-20 and 42-44 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, and further in view of Lincke et al. (U.S. Patent No. 6,253,326, hereinafter "Lincke").

Claims 23 and 47 are rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, further in view of Brim, and further in view of Scholl et al. (U.S. Patent No. 5,742,762, hereinafter "Scholl").

Claim 51 is rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, and further in view of Flack.

Claim 52 is rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, and further in view of Lamming.

Claim 61 is rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, and further in view of Haitani.

Claim 62 is rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, and further in view of Vatanen.

Claim 63 is rejected under 35 USC § 103(a) as being unpatentable over Prithviraj in view of Adams, and further in view of Shipley.

Objections to claims 12 & 36, 16 & 40, 18 & 42 and 20 & 44

The Examiner objects to claims 12 & 36, 16 & 40, 18 & 42 and 20 & 44 due to various informalities. Applicants appreciate the Examiner's suggested corrections, and note that none of the corrections narrows the scope of a claim. The suggestions have been accepted, so objections to claims 12 & 36, 16 & 40, 18 & 42 and 20 & 44 should be withdrawn.

Rejection Under 35 U.S.C. § 112 of Claims 30-35 and 47-48

The Examiner rejects claims 30-35 and 47-48 under 35 U.S.C. § 112 as including terms that have insufficient antecedent basis.

Claims 30, 31, 33, 34 and 35

The Examiner argues that claims 30, 31, 32, 33, 34 and 35 include terms with insufficient antecedent basis. Without narrowing the claims, "inventory" has been

Application No.: 10/019,988**Atty Docket: 3COM 2487-3**

substituted for "management" to conform to claim 25, from which these claims depend. Therefore, claims 30, 31, 32 33, 34 and 35 should not be rejected under § 112.

Claims 47 & 48

The Examiner argues that **claims 47 & 48** include terms with insufficient antecedent basis. Without narrowing the claims, "scope of network inventory information" has been substituted for "network function" to to claim 25, from which these claims depend. Claim 47 also has been amended with respect to "the updated network information. Therefore, claims 47 & 48 should not be rejected under § 112.

Applicants respectfully submit that the rejection of claims 30-35 and 47-48 under § 112 should be withdrawn.

Rejection Under 35 U.S.C. § 103(a) of Claims 49 and 59

The Examiner rejects **claims 49 and 59** under 35 U.S.C. § 103(a) as unpatentable over Prithviraj et al. (U.S. 5,987,513) in view of Adams et al. (U.S. 6,185,566).

Applicants respectfully submit that claims 49 and 59 should be allowable over Prithviraj-Adams.

Claim 49

Claim 49 includes the limitations:

a palm-sized computer running a browser application;

a synchronization server, in communication with the palm-sized computer;
and

a network management server, in communication with the synchronization server

These limitations are not found in Prithviraj-Adams. In particular, neither a palm-sized computer nor a synchronization server are mentioned by either reference. Combining two references that both lack these features cannot create the missing limitations.

The Examiner uses Prithviraj to argue that reference 180 in Prithviraj is a synchronization server. There is no textual support in Prithvaraj for this view. The descriptions of 140 and 180 are either as a gateway (col. 7, lines 22-64) or a router (col.

Application No.: 10/019,988**Atty Docket: 3COM 2487-3**

13, lines 6-7), but never as a synchronization server for a palm-sized computer. The Examiner admits, however, that Prithviraj does not refer to a palm-sized computer.

The Examiner uses Adams to argue that use of portable (not palm-sized) computers were routinely used for network management. The passage from Adams says:

In most instances 45

where network management functionality is required, larger computers (e.g., user workstation) have been used to provide such functionality. This is problematic in networking environments where such larger computers are impractical or unfeasible. For example, in a small to medium sized HVAC 50 (i.e., heating, ventilation and air-conditioning) system, it is not economically prudent to include a larger computer on the network with the embedded controller. Thus, for any network management function to be performed, it is conventional for a technician to arrive with a portable computer and 55 attach it to the network, thereby facilitating certain network management functions.

This passage does not teach or suggest either network management, as opposed to HVAC embedded controller management, and does not teach or suggest using a palm-sized computer. In fact, the suggestion to attach a portable computer directly to the network, at line 55, teaches away from using a synchronization server.

The Examiner further asserts, with passing reference to Xerox's TAB computer (5,862,321) that it would have been obvious to one of ordinary skill in the art to use a palm-sized computer to perform the method taught by Prithvarij. First, Prithvarij does not teach the claimed method. Second, Xerox's TAB did not have nearly enough computing power for one of ordinary skill in the art to substitute it for Prithvarij's computer 160 or 170. See, Roy Want et al. "*The ParcTab Ubiquitous Computing Experiment*" Technical Report CSL-95-1, Xerox Palo Alto Research Center, March 1995 pp. 1-41 (available at <http://sandbox.parc.xerox.com/parctab/csl9501-abstract.html>). Third, just saying so is not enough to prove a *prima facie* case of obviousness for reasons explained below.

To extend a Section 103 rejection beyond the features of the cited references, the Examiner needs to provide evidence of a teaching or suggestion to extend the references to include the claimed features that are admittedly missing. It is

Application No.: 10/019,988**Atty Docket: 3COM 2487-3**

fundamental, as indicated in MPEP § 2143.01, that the Examiner rely on some evidentiary quality suggestion to modify the proposed combination:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also >*In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); <*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

This section of the MPEP cites *In re Lee*, in which the Federal Circuit clarified the need for evidentiary quality support of an Examiner's factual basis for finding a teaching, suggestion or motivation in the prior art (as opposed to the Examiner's opinion), 277 F.3d at 1343-44:

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 U.S.P.Q. (BNA) 769, 775 (Fed. Cir. 1983). ... "The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. [citation omitted] The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). ... In its

Application No.: 10/019,988**Atty Docket: 3COM 2487-3**

decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

The outcome of cases decided even before *In re Lee* makes it clear that real evidence is required to support an asserted teaching, suggestion or motivation to extend references to features missing from the references, for an obviousness rejection. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000) (rev'd finding of obviousness, as "Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference."); *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541 (Fed. Cir. 1997) (aff'd patent not invalid, as no suggestion to modify the '989 patent with regard to non-metallic fibers). Just saying "it's obvious" is an exercise of hindsight that doesn't meet the legal requirements for evidentiary support.

The Examiner's statement of motivation is more a statement of the *result* of modifying Prithviraj-Adams, impermissibly using claim 49 as a blueprint or roadmap, than it is objective evidence of a suggestion to modify Prithviraj-Adams, as required by *In re Lee*. The statement of the *result* of adding to the references what they admittedly lack, uses the claim as a blueprint (20-20 hindsight), which is impermissible. 2-5 Chisum on Patents § 5.03 [2][c] n. 29 (2005 Lexis version); e.g. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998) ("Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention."); *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988) ("Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.'"). The motivation given is not an evidentiary quality suggestion to use a palm-sized computer in communication with synchronization server to manage a network.

The Examiner's argument effectively admits that there is no objective evidence in either of the references of the missing features or of a teaching or suggestion to combine. The Examiner's alternative is to supply an affidavit of his personal knowledge

Application No.: 10/019,988**Atty Docket: 3COM 2487-3**

as to what would be obvious. MPEP § 2144.03, provides guidance as to what more the Examiner must provide in an affidavit or declaration:

If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. See 37 CFR 1.104(d)(2).

An affidavit is particularly appropriate in this case where combination of references that both lack the claimed limitations is proposed and an example from a third reference is clearly inadequate to meet the system needs. Either words in the references or an Examiner's affidavit can be offered as evidence of motivation to combine; conjecture is not enough to satisfy the MPEP or Federal Circuit.

Therefore, claim 49 should be allowable over Prithviraj-Adams.

Claim 50

Claim 50 includes the limitations:

wherein the palm-sized computer is smaller than four inches by six inches
These dimensions are not met by any of the computer devices in Prithviraj-Adams. The Examiner's only example of Xerox's TAB computer is a small device that was not adequate to be substituted for one of Prithviraj's computers or to attach to a network as Adams suggests for a "portable computer". Having traversed the Examiner's claim of obviousness based on his personal knowledge, MPEP § 2144.03 requires that the Examiner now produce an affidavit. As there is no affidavit of record, claim 50 should be allowable over Prithviraj-Adams.

Rejection Under 35 U.S.C. § 103(a) of Claims 1, 2, 6-11, 24-26, 30-35, 48 and 53-60

The Examiner rejects **claims 1, 2, 6-11, 24-26, 30-35, 48 and 53-60** under 35 U.S.C. § 103(a) as unpatentable over Prithviraj et al. (U.S. 5,987,513) in view of Adams et al. (U.S. 6,185,566) in further view of Brim (U.S. 5,835,914).

Applicants respectfully submit that claims 1, 2, 6-11, 24-26, 30-35, 48 and 53-60 should be allowable over Prithviraj-Adams-Brim.

Application No.: 10/019,988**Atty Docket: 3COM 2487-3****Claim 1****Claim 1** includes the limitations:*accessing a page containing network management information stored on a palmsized computer;**indicating a network management function;**connecting to a synchronization server;**transmitting the indicated network management function to the synchronization server; and**receiving updated network management information, responsive to the indicated network management function*

These limitations are not found in Prithviraj-Adams-Brim. The Examiner again relies on Prithviraj-Adams for the elements of a palmsized computer and a synchronization server. For the same reasons as given for claim 49, these limitations are not found in Prithviraj-Adams.

The Examiner further relies on Brim for sophisticated caching of ActiveX controls on web pages. Brim explains in the Summary of Invention:

The present invention is a method of controlling the existence of a software component that is associated with a Web page in order to reuse the software component when the corresponding Web page is revisited. The invention provides a naming control and a class factory object, in addition to modifications to the normal processing within a control. A Web browser receives one or more instructions that define a Web page. The browser translates the instructions to create a Web page, and invokes a command to create a control. The class factory object receives the command and determines whether the desired control has been previously created and remains in existence. If the desired control exists, the class factory returns a reference to the control without creating a new control. If the desired control does not exist, the class factory creates the desired control, returning a reference to the newly created control.

This does not suggest storing a page containing network management information on a palmsized computer, because the page is not first available from a web site. Moreover, the Xerox TAB did not have a fraction of the power needed to implement this sophisticated process and did not have memory to cache controls from web sites for later use. A general caching scheme like Brim is particularly ill-suited to palmsized computers having limited memory, because the memory could be filled or flushed without the claimed network management information being available.

Application No.: 10/019,988**Atty Docket: 3COM 2487-3**

Applicants further respond that there is no objective evidence of a motivation to combine the references and produce the claimed method, when viewed as a whole.

Therefore, claim 1 should be allowable over Prithviraj-Adams-Brim.

Claims 6-11

Claims 6-11 and 24 should be allowable over Prithviraj-Adams-Brim for at least the same reasons as claim 1, from which they depend.

Claim 25

Claim 25 includes the limitations:

accessing a page containing network inventory scope choices stored on a palmsized computer;

indicating a scope of network inventory information;

connecting to a synchronization server;

transmitting the indicated scope of network inventory information to the synchronization server; and

receiving network inventory information, responsive to the indicated scope of network inventory information

These limitations are not found in Prithviraj-Adams-Brim.

Claim 25 should be allowable over Prithviraj-Adams-Brim for at least the same reasons as claim 1, which has similar limitations.

Claims 2 & 26

Claims 2 & 26 should be allowable over Prithviraj-Adams-Brim for at least the same reasons as claims 1/25, from which they depend, and claim 50, which includes similar limitations.

Claims 30-35 and 48

Claims 30-35 and 48 should be allowable over Prithviraj-Adams-Brim for at least the same reasons as claim 25, from which they depend.

Claims 53-60

Claims 53-60 include the limitations:

wherein the palm-sized computer stores a form adapted to request a device configuration [or other particular form]

These limitations are not found in Prithviraj-Adams-Brim.

The Examiner again relies on Brim for sophisticated caching of ActiveX controls on web

Application No.: 10/019,988**Atty Docket: 3COM 2487-3**

pages. Brim, as explained in the Summary of Invention quoted above, does not suggest storing a page containing network management information on a palmsized computer, because the page is not first available from a web site. Moreover, the Xerox TAB did not have a fraction of the power needed to implement this sophisticated process and did not have memory to cache controls from web sites for later use. A general caching scheme like Brim is particularly ill-suited to palmsized computers having limited memory, because the memory could be filled or flushed without the claimed network management information being available.

Applicants further respond that there is no objective evidence of a motivation to combine the references and produce the claimed method, when viewed as a whole.

Therefore, claims 53-60 should be allowable over Prithviraj-Adams-Brim.

Rejection Under 35 U.S.C. § 103(a) of Claims 3, 4, 27 and 28

The Examiner rejects **claims 3, 4, 27 and 28** under 35 U.S.C. § 103(a) as unpatentable over Prithviraj et al. (U.S. 5,987,513) in view of Adams et al. (U.S. 6,185,566) in further view of Brim (U.S. 5,835,914) in further view of Flack et al. (U.S. 6,288,704).

Applicants respectfully submit that claims 3, 4, 37 and 28 should be allowable over Prithviraj-Adams-Brim-Flack for at least the same reasons as the claims from which they depend.

Rejection Under 35 U.S.C. § 103(a) of Claims 5 & 29

The Examiner rejects **claims 5 & 29** under 35 U.S.C. § 103(a) as unpatentable over Prithviraj et al. (U.S. 5,987,513) in view of Adams et al. (U.S. 6,185,566) in further view of Brim (U.S. 5,835,914) in further view of Lamming et al. (U.S. 5,862,321).

In this rejection, the Examiner explicitly relies on Xerox's TAB computer, which is not powerful enough to serve in the proposed combination, as the Examiner argues.

Applicants respectfully submit that claims 5 & 29 should be allowable over Prithviraj-Adams-Brim-Lamming.

Application No.: 10/019,988**Atty Docket: 3COM 2487-3****Rejection Under 35 U.S.C. § 103(a) of Claims 12, 13, 36 and 37**

The Examiner rejects claims 12, 13, 36 and 37 under 35 U.S.C. § 103(a) as unpatentable over Prithviraj et al. (U.S. 5,987,513) in view of Adams et al. (U.S. 6,185,566) in further view of Brim (U.S. 5,835,914) in further view of Haitani et al. (U.S. 5,900,875).

Applicants respectfully submit that claims 12, 13, 36 and 37 should be allowable over Prithviraj-Adams-Brim-Haitani for at least the same reasons as the claims from which they depend.

Rejection Under 35 U.S.C. § 103(a) of Remaining Claims

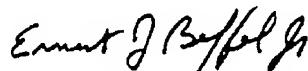
Applicants respectfully submit that the remaining claims should be allowable for at least the same reasons as the claims from which they depend.

CONCLUSION

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims, in light of these amendments.

The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Respectfully submitted,



Dated: 08 August 2005

Ernest J. Beffel, Jr.
Registration No. 43,489

HAYNES BEFFEL & WOLFELD LLP
P.O. Box 366
Half Moon Bay, CA 94019
Telephone: (650) 712-0340
Facsimile: (650) 712-0263